

Remarks

Claims 28-50 are pending in the Application.

Claims 28-43 and 46-49 stand rejected.

Claims 44-45 and 50 stand objected to.

Claim 29-30, 44, and 48 are currently amended.

I. EXAMINER INTERVIEW

On January 27, 2005, the undersigned counsel for Applicant and Dr. Ken Smith, a co-inventor of the Application, met with the Examiner to discuss the Application and the Office Action. Applicant and its counsel appreciate the opportunity to have this discussion and wish to thank the Examiner for the interview.

II. ALLOWABLE SUBJECT MATTER

The Examiner indicated that Claims 44-45 and 50 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Office Action, at 10.

Claim 44 depended directly from independent Claim 28. Applicant has amended Claim 44 herein so that it now includes the limitations from Claim 28. Accordingly, Claim 44, as amended, is now written in independent form, including all of the limitations of the base claim and any intervening claims. Accordingly, amended Claim 44 is now in condition for allowance.

Claims 45 and 50 depended from Claim 44. Thus, Applicant's amendment to Claim 44 has rendered these claims in allowable form.

Accordingly, Applicant respectfully requests that the Examiner withdraw the objections of the Claims 44-45 and 50.

III. INFORMALITIES

The Examiner has objected to Claims 29-30 and 48 due to informalities the claims. Specifically, Examiner has objected to Claims 29 and 30 because the term "comprises" should be changed to -comprise --. *Id.* Furthermore, the Examiner objected to Claim 48 because the term

“single wall carbon nanotubes” should be changed to –aggregates of single-wall carbon nanotubes--. *Id.*

Applicant has made the amendments to Claims 29-30 and 48, as identified by the Examiner. Accordingly, Applicant respectfully requests that the Examiner withdraw these objections of the Claims 29-30 and 48.

IV. § 103(a) REJECTIONS OVER DAVEY IN VIEW OF DILLON AND OTHER ART

Examiner has rejected Claims 28-38, 43, and 48 under 35 U.S.C. § 103(a) as obvious over Davey *et al.*, U.S. Patent No. 6,576,341 (“Davey”) in view of Dillon *et al.*, U.S. Patent Application No. 2002/0150529 (“Dillon”). Office Action, at 3-6. The Examiner has further rejected Claims 39-42 under 35 U.S.C. § 103(a) as obvious over Davey in view of Dillon and further in view of Tohji *et al.*, *Fullerene Sci. and Tech.*, 7(4), pp. 665-679, 1999, (“Tohji”). Office Action, at 6-7. The Examiner has further rejected Claim 46 under 35 U.S.C. § 103(a) as obvious over Davey in view of Dillon and further in view of Bower *et al.*, EP 989579 (“Bower”). Office Action, at 7-8. The Examiner has further rejected Claim 47 under 35 U.S.C. § 103(a) as obvious over Davey in view of Dillon and further in view of Shaffer *et al.*, *Advanced Materials*, 11, No. 11, 1999, pp. 937-941 (“Shaffer”). Office Action, at 8-9. The Examiner has further rejected Claim 49 under 35 U.S.C. § 103(a) as obvious over Davey in view of Dillon and further in view of Hsu, U.S. Patent No. 5,653,996 (“Hsu”). Office Action, at 9.

Applicant traverses these rejections. Dillon is not a valid prior art reference; thus, these rejections are improper and must be withdrawn.

The present Application has a date of priority of August 24, 2000 (U.S. Provisional Patent Application Serial No. 60/227,604). Dillon bases its priority upon PCT Patent application PCT/US01/01698, which was filed January 17, 2001. Thus, the earliest priority date of Dillon is January 17, 2001, which is after the effective filing date of the present Application.

Thus, for this reason alone, all rejections based upon the disclosure in Dillon must be withdrawn.

Applicant further notes that a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a

motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

Thus, even assuming for the sake of argument that *Dillon* could be viewed as prior art, the Examiner has not established a *prima facie* showing of obviousness, because, among other things, there is no such motivation disclosed or taught in the cited art. Applicant further contends the disclosures of the other cited art in these rejections are overstated.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 28-43, and 46-49 under 35 U.S.C. § 103(a).

V. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that the Claims in the Application are now in a condition for allowance, and respectfully requests allowance of such Claims.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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